

Section II. (REMARKS)

The claims pending herein are 1, 2, 4-7, 10, 14, 15, 17-21, 53-57 and 59. Claims 1 and 24 have been amended herein, without prejudice.

Amendment to the Claims

Claims 1 and 24 have been amended to excise the species "1,3-dimethyl-2-imidazolidinone." This does not affect the thrust of these claims and no new search is necessitated.

Allowable Subject Matter

In the September 15, 2008 Office Action, the Examiner objected to claim 57, indicating that it would be allowable if rewritten in independent form. Applicants acknowledge same.

Request for Rejoinder Reminder

Applicants respectfully request rejoinder of method claims 24-31, 33-35, 39, 43-50, and 58 upon allowance of the pending composition claims 1-2, 4-7, 10, 14, 15, 17-21, 53-57, and 59.¹ Towards that end, withdrawn method claim 24 has been amended in a manner consistent with pending composition claim 1.

Rejection of Claims and Traversal Thereof

In the September 15, 2008 Office Action:

claim 1 was rejected under 35 U.S.C. 112, second paragraph;

claims 1-2, 5, 10, 15, 17, 18-21 and 53 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over Sato et al. (U.S. Patent No. 5,849,467); and

claims 1-2, 4-6, 10, 15, 17, 19-21, 53 and 56 were rejected under 35 U.S.C. §102(e) as anticipated by,

or, in the alternative under 35 U.S.C. §103(a) as being unpatentable over Yokoi et al. (U.S. Patent Application Publication No. 20040259761).

These rejections are traversed and reconsideration of the patentability of the pending claims is requested in light of the following remarks.

Rejection under 35 U.S.C. §112

In the September 15, 2008 Office Action, claim 1 was rejected under 35 U.S.C. 112, second paragraph, as being a double inclusion of the term “oxirane, methyl- polymer with oxirane.” Applicants traverse such rejection.

The relevant recitation in claim 1 is:

“wherein the oxirane species comprises a species selected from the group consisting of: *oxirane, methyl-, polymer with oxirane, ether with 2,2'-(oxidoimino)bis(ethanol) (2:1), N(-3(C9-11-isoalkyloxy)propyl)derivatives, C₁₀-rich*; and **oxirane, methyl-, polymer with oxirane, mono(octylphenyl)ether.**” (emphasis added)

Following the use of colons and semi-colons in the above limitation, it can be seen that actually two different oxirane species are disclosed, both beginning with the name “oxirane, methyl- polymer with oxirane.” The first page of the MSDS for both of the emphasized species is provided in **Appendix A**, whereby *oxirane, methyl-, polymer with oxirane, ether with 2,2'-(oxidoimino)bis(ethanol) (2:1), N(-3(C9-11-isoalkyloxy)propyl)derivatives, C₁₀-rich* corresponds to CAS No. 218141-49-2 and **oxirane, methyl-, polymer with oxirane, mono(octylphenyl)ether** corresponds to CAS No. 70955-69-0. Accordingly, the two species are distinct and the claim is definite. Withdrawal of the rejection under §112, second paragraph is respectfully requested.

Rejection in view of Sato et al.

In the September 15, 2008 Office Action, claims 1-2, 5, 10, 15, 17, 18-21 and 53 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over Sato et al. (U.S. Patent No. 5,849,467) (hereinafter Sato). Applicants traverse such

¹ Rejoinder was previously requested in the response to the April 18, 2005 Office Action, filed April 27, 2005.

rejection.

Applicants have amended claim 1 to excise the species 1,3-dimethyl-2-imidazolidinone thereby obviating the novelty rejection.

According to the Examiner:

"In the alternative, the broad teachings and/or suggested [sic] are applied. The above claims are found to be rendered *prima facie* obvious by Sato et al." (see, the September 15, 2008 Office Action, page 8, lines 8-9)

It is initially noted that MPEP, Section 2142 recites:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Further, MPEP, Section 2141 recites:

"When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. [] Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed." (emphasis added)

and

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396, 2141.”

Turning to the present case, the Examiner’s statement that “the broad teachings and/or suggested [sic] are applied” and that “[t]he above claims are found to be rendered prima facie obvious by Sato et al.,” does not amount to articulated reasoning that supports the legal conclusion of obviousness – instead, the Examiner’s statement is merely conclusory and the rejection on obviousness cannot be sustained. See, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (U.S. 2007).

In the event that the Examiner insists that applicants’ claimed invention is obvious in view of Sato, applicants provide the following comments.

Sato relates to a method for the pretreatment of a photoresist layer prior to the pattern-wise exposure of the photoresist layer to actinic rays. Specifically, Sato discloses that during photolithography, photoresist often spreads beyond the defined area for patterning, forming an undesired resist layer on peripheral surfaces and the back surface of the substrate. According to Sato, “[i]t is important . . . that such an extraneous resist layer be removed in a pre-treatment from the substrate surface prior to the pattern-wise exposure to actinic rays since otherwise the processing procedures to follow are greatly disturbed.” For ease of reference, the photolithographic process is illustrated in Appendix B, whereby the step that Sato’s method applies is shown.

Sato further recites that:

“Use of an aqueous alkaline solution is not limited to the pre-treatment of the photoresist layer prior to the pattern-wise exposure of the resist layer to actinic rays but an aqueous alkaline solution is used as a developer solution in the development treatment after pattern-wise exposure and in the whole-surface removing treatment of resist layers. The aqueous alkaline solutions used in these treatments are not quite satisfactory as such in the pre-treatment removal of the photoresist layer prior to the pattern-wise exposure because each of these solutions is formulated to be specifically suitable for the respective treatments under quite different conditions from the pre-treatment as the subject matter of the present invention in respects of the properties of the resist layer to be dissolved away and the solubility behavior of the solution to the particular resist layer.” (see, Sato, col. 2, lines 16-30) (emphasis added)

In other words, Sato is saying that compositions formulated for (i) development treatment after pattern-wise exposure and (ii) whole-surface removing treatment of resist layers are not satisfactory for pre-treatment removal of resist because the properties of the respective resist layers as well as the solubility behavior of the compositions for the respective resist layers are all different. Accordingly, one skilled in the art would not consider the Sato teaching composition for the removal of whole-surface resist later in the manufacturing process (again, refer to **Appendix B**). Considered *in toto*, the burden will be on the Examiner to clearly articulate reason(s) why the claimed invention would have been obvious in view of Sato, especially considering Sato's own admissions discussed hereinabove.

In conclusion, applicants respectfully request the Examiner withdraw the rejections of claims 1-2, 5, 10, 15, 17, 18-21 and 53 as being anticipated and/or non-obvious in view of Sato.

Rejection in view of Yokoi et al.

In the September 15, 2008 Office Action, the Examiner rejected claims 1-2, 4-6, 10, 15, 17, 19-21, 53 and 56 were rejected under 35 U.S.C. §102(e) as anticipated by, or, in the alternative under 35 U.S.C. §103(a) as being unpatentable over Yokoi et al. (U.S. Patent Application Publication No. 20040259761) (hereinafter Yokoi '761). Applicants traverse said rejection.

The Examiner previously argued in the April 13, 2006 Office Action that the elected claims were rejected as being anticipated in view of Yokoi '761. In response, applicants submitted a Declaration under 37 CFR §1.131 on August 17, 2006, wherein applicants attested to conception and reduction of practice of the presently claimed invention prior to such of the earliest claimed June 18, 2003 date of Yokoi '761 (a copy of the previously submitted Declaration is included herewith in **Appendix A**). Importantly, in the November 6, 2006 Office Action, the Examiner stated that:

“[a]pplicants submit a declaration under Rule 131, that the claimed embodiments are before the applied date of 18 June 2003 of Yokoi et al on the record. Accordingly, the rejections in the Office action mailed on 13 April 2006 are withdrawn.” (see, the November 6, 2006 Office Action, page 3, lines 12-15, and the November 24, 2006 corrected Office Action, page 4, lines 1-4)

In other words, the rejection of claims 1-2, 4-6, 10, 15, 17, 19-21, 53 and 56 as being anticipated by Yokoi '761 has already been overcome. Withdrawal of said rejection is respectfully requested.

It is noted that this is the third time the Examiner has presented this rejection. In addition to the April 13, 2006 Office Action, the Examiner also presented this rejection in the July 9, 2007 Office Action. It is unnecessary to present it for a fourth time in view of the Examiner's admission that the rejection was overcome.

Double Patenting Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

In the September 15, 2008 Office Action, the Examiner rejected claims 1, 2, 4-7, 10, 14-15, 17-21 and 53-57 under the judicially created doctrine of obviousness-type double patenting. Specifically, the Examiner stated that said claims are:

“unpatentable over claims 1-7, 9-17, 21-22 and 33-48 as amended on 03/31/08 of co-pending application No. 10/389,214 (and its teachings and suggestions in the specification on at least paragraphs 9, 12, 13, 17, 18, 21, 23, Examples 2, 4 and 5). Applicants, assignee and their counsel may and should disagree, urge and state on and for the record that each of the claims as originally filed is self sufficient. There has not been and will not be relied on any embodiment and any application for any purpose) considered in view of En et al (2004/0134682).” (see the May 6, 2008 Office Action, page 4).

Applicants traverse such rejection.

The Examiner, commenting on Applicants response to the (same) rejection presented in the May 6, 2008 Office Action, specifically recited:

“(1) Applicants look at the applied claim 7 alone with their arguments. It is insufficient. The record shows that the applied compounds are also on [sic] paragraph 18 of the applied specification.” (see, the September 15, 2008 Office Action, page 6, point (1))

To reiterate our response to the May 6, 2008 Office Action, as a matter of law, the test for obviousness-type double patenting is whether the claimed invention of the subject application would have been obvious from the subject matter of the claims in the cited reference, in light of the prior art. *See, In re Longi*, 225 U.S.P.Q. 645 (Fed. Cir. 1985). Not only does the Examiner admit that he is resorting to teachings in the specification of application No. 10/389,214 (hereinafter the ‘214

application) when establishing the rejection,² but the Examiner is also admitting that “the record shows that the applied compounds are also on [sic] paragraph 18 of the applied specification [of the ‘214 application].” The courts have made it clear – the Examiner must NOT refer to the specification of the ‘214 application in an attempt to establish a rejection based on obviousness-type double patenting, only the claims. Still the Examiner continues to reject applicants’ claims while completely ignoring the holding provided by the United States Court of Appeals for the Federal Circuit.

The Examiner relies on En as a secondary reference “for the teachings and/or suggestions of a use of an alkali base.” According to the Examiner, “[a]pplicants have missed interpretations of the rejection on the record and looked at a different direction in the applied reference than those on the record” (see, the September 15, 2008 Office Action, the sentence bridging pages 6-7). Applicants vigorously disagree.

As introduced hereinabove, the “key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” In the present case, the Examiner has admitted on multiple occasions that he has resorted to the specification of the ‘214 application in an attempt to establish a *prima facie* case of judicially created doctrine of obviousness-type double patenting. Applicants have not “missed interpretations” or “looked at a different direction,” but rather have transferred the burden back to the Examiner to establish a legally permissible rejection of obviousness-type double patenting. By legally permissible, the Examiner must clearly articulate why the presently pending claims are unpatentable over the claims of the primary ‘214 application in view of the En reference. Since the examiner has not produced a *prima facie* case of obviousness-type double patenting, the applicant is under no obligation to respond further to this rejection.

Applicants respectfully request withdrawal of the rejection of claims 1, 2, 4-7, 10, 14-15, 17-21 and 53-57 under the judicially created doctrine of obviousness-type double patenting.

Petition for Extension of Time/Fees Payable

² “Claims 1, 2, 4-7, 10, 14-15, 17-21 and 53-57 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 9-17, 21-22 and 33-48 as amended on 03/31/08 of co-pending application No. 10/389,214 (and its teachings and suggestions in the specification on at least paragraphs 9, 12, 13, 17, 18, 21, 23, Examples 2, 4 and 5).” (see, the September 15, 2008 Office Action, the sentence bridging pages 3-4)

Applicants hereby petition for a one (1) month extension of time, extending the deadline for responding to the September 15, 2008 Office Action from December 15, 2008 to January 15, 2009. The fee of \$130.00 specified in 37 CFR §1.17(a)(1) for such one (1) month extension is hereby enclosed.

The total fee of \$130.00 is being paid by Electronic Funds Transfer. Authorization is hereby given to charge any deficiency in applicable fees for this response to Deposit Account No. 13-4365 of Moore & Van Allen PLLC.

Conclusion

Claims 1, 2, 4-7, 10, 14, 15, 17-21, 53-57 and 59 are in form and condition for allowance. If any additional issues remain, the Examiner is requested to contact the undersigned attorney at (919) 286-8090 to discuss same.

Respectfully submitted,

MOORE & VAN ALLEN PLLC



Date: January 15, 2009

By: _____

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Appendix A

MATERIAL SAFETY DATA SHEET



Page 1
DATE PREPARED: 12/04/2004
MSDS No: 214104
AO-455

1. CHEMICAL PRODUCT AND COMPANY IDENTIFICATION

Product Identifier: AO-455
Product Description: Amine oxide

MANUFACTURER:
TOMAH Products
1012 Terra Drive
P. O. Box 388
Milton, WI 53563
Customer Service: (608) 868-6811

**24 HR. EMERGENCY TELEPHONE
NUMBERS:**
CHEMTREC (800) 424-9300
Emergency Phone (608) 868-6811

2. COMPOSITION/INFORMATION ON INGREDIENTS

Component	wt%	CAS Registry #
Oxirane, methyl-, polymer with oxirane, ether with 2,2'-(oxidoimino)bis[ethanol] (2:1), N-[3-(C9-11-Isalkyloxy)propyl] deriva., C10-rich	50%	218141-49-2
Water	50%	7732-18-6

OSHA HAZARDOUS COMPONENTS (29 CFR 1910.1200)

Component	EXPOSURE LIMITS		
	OSHA PEL	ACGIH TLV	Supplier
Oxirane, methyl-, polymer with oxirane, ether with 2,2'-(oxidoimino)bis[ethanol] (2:1), N-[3-(C9-11-Isalkyloxy)propyl] deriva., C10-rich	None Established	None Established	

3. HAZARDS IDENTIFICATION

EMERGENCY OVERVIEW

IMMEDIATE CONCERNS:

Caution!
Causes eye irritation
May cause skin irritation
May cause respiratory tract irritation

Do not mix with nitrating agents



MATERIAL SAFETY DATA SHEET

Section 1

PRODUCT IDENTIFICATION

PRODUCT NAME: NORDIC PENETRANT
Product code: 93-UFW-
Product type: Wetting Agent
Emergency: CHEMTREC 1-800-424-9300

Section 2

INGREDIENT INFORMATION

The ingredients listed below have been associated with one or more immediate and/or delayed (*) health hazards. Risk of damage and effects depends upon duration and level of exposure. BEFORE USING, HANDLING, OR EXPOSURE TO THESE INGREDIENTS, READ AND UNDERSTAND THE MSDS.

70955-69-0	*Oxirane, methyl-, polymer with oxirane, mono (octylphenyl) ether, branched	% by weight 30-50
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Section 3

HAZARDS IDENTIFICATION

3.1 EMERGENCY OVERVIEW

Appearance	Clear liquid
Odor	Little or none

WARNING!

Causes chemical burns to eyes.
May be harmful if swallowed.
May be harmful if inhaled May cause irritation of nose, throat and lungs.

HMIS HAZARD RATING

3	HEALTH
0	FLAMMABILITY
0	REACTIVITY
*	CHRONIC

Appendix B

